

**REMARKS/ARGUMENTS**

Claims 1-11 are pending herein. The specification and Abstract have been amended for clarification purposes only.

Examiner Jimenez is thanked for courtesies extended to Applicants' representative (Steven Caldwell) during a telephonic interview on November 18, 2004. During the interview, Examiner Jimenez tentatively agreed that Applicants' arguments (reiterated below as requested by Examiner Jimenez) overcome the art-based rejection of record.

1. Claims 1-10 were rejected under § 103(a) over Itoh in view of Narita.\*

As discussed above, Examiner Jimenez tentatively agreed that pending claim 1, as presently drafted, defines patentable subject matter over the above-identified combination of applied prior art references. Specifically, Examiner Jimenez agreed that while Narita discloses a resistance adjustment layer (i.e., a conductive elastic layer as alleged in the Office Action) that can alternatively be formed from thermoplastics or rubber materials, Narita does not disclose or suggest that the resistance adjustment layer can include a combination of thermoplastics and rubber materials (see, for example, paragraph [0003] of the machine translation of Narita). As such, even if Itoh and Narita were combined as asserted in the Office Action, the resultant structure would correspond to Itoh's resistance adjusting layer (i.e., a conductive elastic layer as alleged in the Office Action) being formed from a thermoplastic material including conductive particles or a rubber material including conductive particles. That is, the combination of the prior art asserted in the Office Action would still fail to disclose or suggest a combination of a rubber material and a thermoplastic resin, and certainly would not teach such a combination including a thermoplastic resin having cross-linkable double bonds, as claimed.

Notwithstanding the fact that Examiner Jimenez agreed that the above-discussed combination of Itoh and Narita would not result in Itoh's resistance adjusting layer being formed from a combination of a rubber material and

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\* It is unclear to Applicants whether this rejection was intended to cover pending claims 1-11. This point is moot, however, in view of the fact that Examiner Jimenez has agreed to withdraw this rejection.

thermoplastic resin, he requested that Applicants discuss the reasons why skilled artisans would understand that Narita's generic disclosure of a thermoplastic resin does not inherently encompass thermoplastic resins having cross-linkable double bonds, as claimed. Applicants have reviewed the Japanese language version of Narita in its entirety and respectfully submit that skilled artisans would know that generic disclosure of ether-type urethanes in Narita does not *necessarily* disclose a type of thermoplastic resin having cross-linkable double bonds, as claimed.\*\* In fact, Applicants respectfully submit that at least one of Narita's disclosed thermoplastic resins (Elastollan ET880 from Takeda Badische Urethane Industries, Ltd., Japan) does not include cross-linkable double bonds, as claimed.

In view of all of the foregoing, reconsideration and withdrawal of the §103(a) rejection are respectfully requested.

2. Claims 1-10 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-10 of co-pending application No. 10/649,053. The PTO is requested to hold this rejection in abeyance until after the art-based rejection of record has been withdrawn. Applicants will thereafter file a Terminal Disclaimer.

If Examiner Jimenez believes that further contact with Applicants' attorney would be advantageous toward the disposition of this case, he is herein requested to call Applicants' attorney at the phone number noted below.

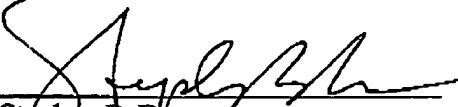
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\*\* To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed.Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 USPQ2d at 1749 (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981).

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment to Deposit Account No. 50-1446.

Respectfully submitted,

December 6, 2004  
Date

  
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